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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,946	05/22/2006	Swee Hin Teoh	2597.004 (FP3037/GM)	3587

23405 7590 12/13/2010
HESLIN ROTHENBERG FARLEY & MESITI PC
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ALBANY, NY 12203

EXAMINER

PRONE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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12/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,946	Applicant(s) TEOH ET AL.	
	Examiner CHRISTOPHER D. PRONE	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-10,13,19,20,23-44 and 71-83 is/are pending in the application.
- 4a) Of the above claim(s) 38 and 71-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10,13,19,20,23-37,39-44 and 83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/27/10 12/11/08
12/4/06 5/22/06.

DETAILED ACTION

Priority

This application claims priority from provisional application 60/524278, filed on 11/21/03.

Election/Restrictions

Applicant's election of Invention 1, species 1 shown in figure 4A and claims 1-5, 8-10, 13, 19, 20, 23-37, and 39-44 in the reply filed on 10/27/10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Status of Claims

Claims 1-5, 8-10, 13, 19, 20, 23-44, and 71-83 are pending.

Claims 38 and 71-82 have been withdrawn.

Claims 6, 7, 11, 12, 14-18, and 45-70 have been cancelled.

Claim Objections

Claims 23-44 are objected to because of the following informalities: unmarked amendments. In their original form these claims were method claims requiring numerous structural components that are not in their current language, but they have not been marked appropriately.

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Claims 4, 5, 20, 26, 27, and 42 are objected to because of the following informalities: lack of antecedent basis for the claim language.

Claims 4 and 26 recite the limitation "the area" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 5 and 27 recite the limitation "the first and second surface" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 20 and 42 recite the limitation "the bioabsorbable scaffold" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone et al. (Stone) USPN 5,306,311.

Stone discloses the same invention being a cone shaped porous bioabsorbable plug implant comprising first and second circular planar portions having a tapered surface and a bioactive agent shown best in figure 4B

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 13, 20, 23-37, 39-44, and 83 are rejected under 35 U.S.C. 103 as being unpatentable over Stone in view of Masters USPN 2002/0028243 A1.

Stone discloses the invention substantially as claimed being described supra. However, Stone does not disclose the TCP-PLC materials.

Masters teaches the use of medical implants comprising layers of TCP and PLC and that the layers are seeded with stem cells in the same field of endeavor for the purpose of providing a bioabsorbable implant capable of controlled drug delivery.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the materials of Masters with the implant of Stone in order to provide an implant capable of being readily absorbed into the implant site and deliver a controlled drug.

In regards to claims 10, 23, 33, 34, 39, and 40 the claim language is requiring steps of making and using the implant. These steps are all given limited weight because the elected invention is the device and the device of Stone as modified by Masters is fully capable of being made and used in the claimed manner.

Additionally since the combination discloses the same material as required by the claims, it is considered to have all the same properties and perform in the same manner as that of the current application.

Examiner's Comments

In order to advance prosecution the applicant is advised to amend the independent claims to define the basic shape of the elected embodiment (truncated cone) and to better define the novel aspect of the materials used to make the implant. The applicant is reminded that the amendments should focus on the materials themselves such as percentages/properties and not the steps of making or assembling the implant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday through Fri 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone
Examiner
Art Unit 3738

/Christopher D Prone/
Examiner, Art Unit 3738

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738